

Application No. 09/908,943
 Amendment dated November 16, 2006
 Reply to Office Action of May 18, 2006

Docket No.: 29915/00281A.US

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REMARKS

I. The rejection under 35 U.S.C. 112, first paragraph should be withdrawn.

The Examiner maintained the rejection of claims 102-109 and 117-131 under 35 U.S.C. 112, first paragraph for lack of adequate written description. The Examiner asserted that the state of the art suggests that the Applicants were not in possession of the claimed invention and have not provided a sufficient description to support the broad genus recited in the claims. Applicants maintain that these claims are adequately described.

Claims 102-109 and 117-131 read on substrates that are longer than 6 amino acids and the recited substrates must be cleavable by a human aspartyl protease encoded by SEQ ID NO: 1 or SEQ ID NO: 3. Through the combination of structural and functional limitations, the claims read only on "active" (cleavable) substrates. Furthermore, the specification exemplifies 48 species that are structurally defined by the claimed genus (see page 20, lines 5-14, page 21, lines 12-22, page 24, lines 3-10, page 25, lines 1-14, page 26, lines 3-25), and provides data to demonstrate that 26 of the disclosed species are cleaved between the P₁ and P_{1'} residues by a human aspartyl protease.

For these reasons and those described in detail in Applicants' previous response, the disclosure in the specification demonstrates that Applicants were in possession of the claimed genus at the time of filing. However, to expedite prosecution, claims 102, 103 and 117 are canceled without prejudice by the foregoing amendment. Claims 104-109 and 118-131 are amended to depend from claims 110-116, and therefore are adequately described by the specification. Applicants reserve the right to pursue claims of the same or similar scope in a continuing application. Therefore, the rejection under 35 U.S.C. § 112, first paragraph is now moot and should be withdrawn.

II. Double Patenting

The Examiner provisionally rejected claims 102-131 under 35 U.S.C. § 101 for "same type" double patenting in view of claims 84-107 in co-pending Application Nos. 10/801,493, 10/801,509 and 10/801,983. As noted by the Examiner, claims 84-107 in the co-pending applications have not yet been allowed and these rejections are provisional. It would

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appear that the pending claims should be the first to issue, and the provisional rejections should be withdrawn for this reason. (See MPEP § 804).

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CONCLUSION

Applicants respectfully request that the Examiner exercise discretion in favor of entering the foregoing amendment, as this amendment puts the application in condition for allowance and does not raise any new issues requiring an additional search or significant examination. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection and to pass this application to issue.

Dated: November 16, 2006

Respectfully submitted,

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